

REMARKS

Claims 28-46 are in this case.

Reconsideration of the rejection for double patenting is requested. This case has the same effective filing date as the parent case (now Patent No. 06/282,513). Therefore, any patent granted on this application will expire 20 years after said filing dated the same as in the case of applicant's prior patent.

In 1995 Congress passed a law providing that a patent expires 20 years after its effective filing date and not 17 years after grant of a patent. That law had the effect of drastically changing the rules of double patenting. The examiner is applying the old law; indeed all of the cases cited by the Examiner deal with the old law and do not apply here.

MPEP Sec. 800 makes it clear over and over again that the doctrine of double patenting applies to cases where the second patent would extend the monopoly which is not the case here. As evidence, see Rivera U.S. Patent 6,097,127 which has much the same disclosure as earlier Rivera patent 5,912,127, and indeed has broader claims than the claims of the earlier patent.

There are two types of double patenting, statutory and non-statutory (See MPEP 804.02). The MPEP states (804.02):

"A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope."

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Applicant disagrees with the Examiner's summary of Dorne in view of Wenstrup, number 5 at the bottom of page 2 of the last Office Action.

Dorne's Col. 6, lines 9-17 say and I quote, "The procedure menus list a

variety of procedures contained in each major category. For example, by selecting the Aortic, thoracic, the interactive program displays an examination screen (FIG> 3C) containing a variety of related procedures. The examination screen contains multiple buttons, each of which represents a procedure. Several examination screens have one or more sub-screens to handle the large number of procedures grouped under one type of examination. For instance, the examination screen illustrated in FIG. 3C contains an ADDITIONAL SELECTIVES BUTTON 136.”. Nowhere does Dorne express a standard protocol of operations that an operator should perform when using a medical machine to perform a medical function. A copy of FIG. 3 is attached.

Dorne’s Col. 6, lines 38-40 says and I quote, “The user interacts with the interactive program by selecting specific procedure buttons corresponding to a planned examination or a performed examination. Nowhere does Dorne express an apparatus for receiving, and entering into said memory, the operations of the operator of said machine during the use of the machine to perform said medical function.

Dorne’s Col. 11, lines 30-35 says and I quote, “After determining the specific examination record the user enters the procedures that were involved during the patient examination. Specifically, the user selects between the major procedural categories illustrated by the screen display of FIG. 3A.”. Nowhere does Dorne express an apparatus for receiving, and entering into said memory, the operations of the operator of said machine during the use of the machine to perform said medical function. A copy of FIG. 3A is attached.

Dorne’s Col. 6, line 67 - Col. 7, line 24 says and I quote, “If the user returns to the Main Menu (FIG.3A), the interactive program generates the CPT codes

associated with the selected procedures, separates the codes into radiological codes and non-radiological codes, and orders the codes in descending order of RVU values within each code grouping, as illustrated in FIG. 3F...". Dorne analyzes data for correlating medical procedures into billing codes. (Col. 3 line 19-20)

Dorne's system translates medical procedures into accurate billing codes... (Col. 3, line 22-33)

Wenstrup's Col. 8, line 53 - Col. 9, line 30 says and I quote, "The x-ray technologist then repeats the exposures of the template10,...". Nowhere in Wenstrup et al patent is it expressed to compare the standard protocol of the examination with the actual operations performed by the operator.

Wenstrup et al U.S. patent 5,544,1570 clearly teaches a need to provide a calibration template for standardizing images taken by a computerized x-ray machine, not with a conventional x-ray machine. Wenstrup employs a box with elements to compare images making sure the visual display of images is similar in detail for each image.

Wenstrup et al teaches how a box may produce uniform results (such as in the case of computerized imaging and has nothing to do with how an operator may operate the machine that performs the examination. There is no suggestion that there should be a standard protocol of operations and that the actual operations of an operator should be compared to said standard protocol.

If the combination of Dorne and Wenstrup et al is made it does not meet the claims of applicant, neither Dorne nor Wenstrup et al teach the individual operations of the operator of a medical machine nor place the individual operations of the operator of a medical machine into the computer and therefore

has nothing to do with the present invention.

Fig. 3C of Dorne's patent (U.S. Patent No. 5,325,293) clearly shows that Dorne can only select a type of procedure that was performed (which is to be billed) but can not compare or analyze the performance of the operate during or at the completion of the procedure.

MPEP Sec. 2143.01 says quote:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so >. *In re Khan*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as whole would have suggested to those of ordinary skill in the art."

MPEP Sec. 2143.03 says quote:

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royke*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "All words in a claim must be considered in judging the patentability of that claim against the prior art."

The claims in this case are different in scope from the claims in the parent application.

Claim 28 patentably defines over the prior art by calling for "a standard

protocol,” “entering the operations of the operator” and the “comparing said standard protocol with the operations that were entered by said apparatus.”

Claim 29 is patentable as it calls for “prices computed from the operations performed by said machine.”

Claim 30 is patentable by reason of the statements in line 2 of the claim in combination with the recitals of the parent claim.

Claim 31 is patentable as it calls for the operations of the parent claim to be performed on a plurality of machines, in combination with claim 28.

Claim 32 is patentable since it calls for at least one computer for each machine.

Claim 33 is similar to claim 28, except it is in method format and is patentable for the same reasons as claim 28.

Claim 34 is patentable since it calls for computing prices in combination with the steps of claim 33.

Claim 35 is patentable since it calls for plural machines in the combination of steps of claim 33.

Claim 36 is patentable since it calls for one computer for each machine in the combination of claims 33 and 35.

Claim 37 is patentable in view of its recitals in lines 2 and 3 in combination with the steps of claims 33 and 35.

Claim 38 is patentable in view of its last three lines in combination with claim 33.

Claim 39 is patentable since it calls for “prices useful for billing purposes” in the combination of claim 33.

Claim 40 is patentable since it calls for “takes a picture” in combination of

claim 28.

Claim 41 is patentable since it calls for "taking a picture" in the combination of claim 33.

Claims 42-45 are patentable since they require entry of the operations into computer memory before the machine completes its function. Dorne does not enter his second entry until after the function is performed.

Claim 46 is patentable since it deals with a double checking the work of operation of a medical machine whereas Dorne deals only with the end results and not to operations of a machine that produces a result.

Respectfully,

A handwritten signature in black ink, reading "William D. Hall". The signature is fluid and cursive, with a horizontal line drawn underneath it.

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